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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92047433
Party	Defendant Jay-Y Enterprise Co., Inc.
Correspondence Address	KENNETH L WILTON SEYFARTH SHAW LLP 2029 CENTURY PARK E , SUITE 3500 LOS ANGELES, CA 90067-3021 UNITED STATES kwilton@seyfarth.com
Submission	Other Motions/Papers
Filer's Name	Kenneth L. Wilton
Filer's e-mail	kwilton@seyfarth.com, jsutherland@seyfarth.com
Signature	/Kenneth L. Wilton/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

GADO S.R.L.,

Petitioner,

v.

JAY-Y ENTERPRISE CO., INC.,

Respondent.

AND RELATED COUNTERCLAIM.

Cancellation No. 92047433

**JAY-Y ENTERPRISE CO., INC.’S EVIDENTIARY OBJECTIONS TO NEW**  
**EVIDENCE REFERENCED IN GADO S.R.L.’S BRIEF IN OPPOSITION TO THE**  
**COUNTERCLAIM AND IN REPLY TO RESPONDENT’S OPPOSITION BRIEF**

Respondent Jay-Y Enterprise Co., Inc. (“Jay-Y”) hereby objects to new evidence referenced by petitioner Gado S.R.L.(“Gado”) in its December 2, 2011 Brief In Opposition To The Counterclaim By Respondent And In Reply To Respondent’s Opposition Brief (“Reply Brief”). Pursuant to the objections, Jay-Y requests that the evidence be stricken.

**I. INTRODUCTION**

In its Reply Brief, Gado refers for the first time to the deposition of Roberto Lupano, and to a single exhibit – Exhibit 49 – introduced during Mr. Lupano’s testimony. Mr. Lupano was not deposed during Gado’s opening trial testimony period, but rather was deposed as a “rebuttal” witness during Gado’s rebuttal testimony period. As discussed herein, Mr. Lupano’s testimony is cited for two issues, the purported date of first use of the D&G DOLCE & GABBANA mark and the amounts allegedly spent by Gado advertising that mark in the United States. Both of

those issues fall squarely within Gado's case-in-chief, and should have been introduced during Gado's opening trial testimony period. Because the evidence constitutes improper rebuttal, it should be stricken and disregarded.

Moreover, even had it been properly introduced, Mr. Lupano's testimony regarding the alleged first use of the D&G DOLCE & GABBANA mark was based on Mr. Lupano's alleged review of records of Gado that Gado never introduced. As a result, his testimony is hearsay and violates the best evidence rule.

Finally, in its Reply Brief Gado references several articles that it relies upon to support its claimed date of first use of the "D&G" mark. To the extent these articles are being introduced for the truth of the matters stated therein, they constitute inadmissible hearsay. The Board should not consider these references in determining the date of first use of Gado's "D&G" mark.

**II. THE TRIAL TESTIMONY DEPOSITION OF ROBERTO LUPANO**  
**AND EXHIBIT 49 SHOULD BE STRICKEN AS IMPROPER**  
**REBUTTAL**

A. All of Mr. Lupano's Testimony Relates To Issues That Constitute Part Of Gado's Case-In-Chief.

Apparently realizing that it had failed to present evidence of an essential element of its case-in-chief – namely advertising figures related to its D&G DOLCE & GABBANA mark – during its rebuttal trial testimony period Gado took the trial testimony deposition of Roberto Lupano.<sup>1</sup> Mr. Lupano is the "media manager for planning and buying at Dolce & Gabbana SRL Worldwide." (Lupano Depo. 4:25-5:2.) He has been working for Dolce & Gabbana SRL, in the

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<sup>1</sup> By Stipulation filed February 21, 2011 (Docket No. 52), approved by Order dated March 1, 2011 (Docket No. 53), Gado's Testimony Period as Defendant in the Counterclaim and its Rebuttal Testimony as Plaintiff in the Cancellation was set to close on May 23, 2011. Mr. Lupano was deposed on May 6, 2011, during that period.

same position, since January 1998. (Id. at 9:9-14.) As a consequence, he was available to testify as a witness throughout this proceeding.

Mr. Lupano's entire testimony related to two areas: the purported launch date of goods sold under the D&G DOLCE & GABBANA mark and the purported advertising done by Gado in the United States. (See, e.g., Lupano Depo. at 11:13-13:24.) In fact, it is precisely these two areas for which Gado cites Mr. Lupano's testimony in its Reply Brief:

- Reply Brief at 3      setting forth purported advertising spend in the United States for “the DOLCE & GABBANA line” in the United States from 1992 to 2009;
- Reply Brief at 4      placing a date on the purported launch of the “D&G DOLCE & GABBANA collection” and describing yearly and total advertising expenditures for “the D&G DOLCE & GABBANA line” from 1995 to 2009;
- Reply Brief at 7      describing Gado's advertising and the amount allegedly spent promoting “the D&G DOLCE & GABBANA line”;
- Reply Brief at 8      relating to a specific advertising campaign involving the model Linda Evangelista;
- Reply Brief at 10    stating that “Gado began advertising the Jay-Y line [sic] in 1995”;
- Reply Brief at 12    discussing Gado's advertising spend during the period from 1989 to the present;
- Reply Brief at 14    stating the purported amount spent “promoting the DOLCE & GABBANA line” from 1994 to 2003;

- Reply Brief at 17 placing a date on the purported launch of the “D&G DOLCE & GABBANA collection” and describing yearly and total advertising expenditures for “the D&G DOLCE & GABBANA line” from 1995 to 2009.

B. Because The Evidence Presented By Mr. Lupano Forms Part Of Gado’s Case-In-Chief And Should Have Been Presented In Gado’s Opening Testimony Period, It Is Improper Rebuttal And Should Be Stricken

It is axiomatic that “evidence which should constitute part of [the] case in chief, but which is made of record during the rebuttal period, is not considered when the [other party] objects.” *Automedx, Inc. v. Artivent Corp.*, 95 USPQ2d 1976, 1977 (TTAB 2010) (citing *General Electric Company v. Graham Magnetics Incorporated*, 197 USPQ 690, 692 n.5 (TTAB 1977)). It is equally clear that evidence of fame, such as advertising expenditures, as well as evidence of use, were properly part of Gado’s case in chief. *See Calypso Technology, Inc. v. Calypson Capital Management LP*, 100 USPQ2d 1213, 1220 n.12 (TTAB 2011) (holding that even had plaintiff submitted evidence of its first use in rebuttal, “it would not have been acceptable rebuttal, since proving priority is part of a plaintiff’s case in chief”); *Hard Rock Café International (USA), Inc. v. Elsea*, 56 USPQ2d 1504, 1505 (TTAB 2000) (“fame must be proved as part of case-in-chief, and not during rebuttal”).

The evidence presented by Mr. Lupano was clearly intended to try to fill in gaps in the evidence Gado introduced during its case-in-chief, namely by including the purported date of its first use of its D&G DOLCE & GABBANA mark and advertising expenditures related to that mark. Mr. Lupano goes so far as to clarify testimony of Ms. Forte, testimony that was presented in Gado’s opening trial testimony period. (See Pet. Reply Brf. at 8 (“Mr. Lupano testified that

the Linda Evangelista campaign referred to by Ms. Forte indeed took place in the fall of 1995”).) Because the evidence should have been presented in Gado’s case-in-chief, it should be stricken.

Moreover, Gado cannot rely on the procedural posture of this proceeding to excuse its failure to call Mr. Lupano in its case-in-chief. The issues raised by Jay-Y’s counterclaim – whether Jay-Y has priority in its use of its DG Marks and whether there is a likelihood of confusion between Jay-Y’s DG Marks and Gado’s D&G mark – do not in any manner implicate Gado’s purported advertising of goods under its D&G DOLCE & GABBANA mark.

Jay-Y is asserting that it commenced use of its DG Marks in 1993 and, if there is a likelihood of confusion between those marks and Gado’s D&G mark, then Jay-Y should prevail on its counterclaim for cancellation. Mr. Lupano’s testimony regarding advertising concerning the D&G DOLCE & GABBANA mark is wholly unrelated to the issues on the counterclaim. Even if it were related to the counterclaim, testimony or evidence that should have been introduced during the case-in-chief cannot be introduced during rebuttal. *Carefirst of Maryland Inc. v. First Health of the Carolinas, Inc.*, 77 USPQ2d 1492, 1498 (TTAB 2005) (granting opposer’s motion to strike evidence that was both relevant to applicant’s counterclaim and its case-in-chief, but introduced during rebuttal testimony period). Thus, it is plain that Mr. Lupano did not “deny, explain or refute” any evidence presented by Jay-Y. In fact, the only instances of Jay-Y even being mentioned during Mr. Lupano’s deposition were in the caption and the introductions by counsel. (Lupano Depo. 1:7, 3:18, 132:19.)

All of Mr. Lupano’s testimony should be stricken and not be considered.

**III. MR. LUPANO’S TESTIMONY REGARDING THE CREATION OF  
THE D&G DOLCE & GABBANA LINE IS HEARSAY AND  
SHOULD NOT BE CONSIDERED**

Even if one ignores the impropriety of Gado’s decision to call Mr. Lupano as a rebuttal witness, the portion of his testimony relating to the purported first use of the D&G DOLCE & GABBANA mark must be excluded on grounds that it is hearsay. The portion of Mr. Lupano’s testimony cited by Gado is as follows:

- Q. Do you know as to the D&G line, when that was first advertised in the United States?
- A. Well, it was found in 1994. And the first advertising campaign from my records is 1995.
- Q. The records you’re referring to are the advertising department’s records?
- A. Yes.

Rule 1002 of the Federal Rules of Evidence states that, “[t]o prove the content of a writing, . . . the original writing . . . is required, except as otherwise provided in these rules or by Act of Congress.” While there are a string of exceptions to the rule, none of them allow a party to simply produce a witness that states, “I looked at the records of the company and this is what they say.” This is particularly true where the issue sought to be proven – the date of first use of one of Gado’s marks – is a central issue in the proceeding. *Cf., Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1707-08 (TTAB 2010) (allowing introduction of sales summaries over best evidence objection where summaries were prepared by personnel under the supervision of witness, witness had personal knowledge of the underlying facts, and purposes of introducing summaries “are not closely related to the controlling issues involved in the likelihood of confusion analysis”).

Because Mr. Lupano was not even employed at Gado when the D&G DOLCE & GABBANA mark purportedly was introduced and thus lacks personal knowledge of the underlying facts contained in the records, and because Gado did not introduce the business records upon which Mr. Lupano based his testimony, his testimony violates the best evidence rule and is hearsay.

**IV. THE ARTICLES RELIED UPON BY GADO TO ESTABLISH THE DATE OF FIRST USE OF ITS “D&G” MARK ARE INADMISSIBLE HEARSAY AND SHOULD NOT BE CONSIDERED.**

In its Reply Brief, Gado relies on several articles to support its asserted date of first use of its D&G mark. By way of example, these include Forte Depo. Ex. 17 (September 1995 Details Magazine), p. 30 (containing photographs of individuals wearing clothing bearing the D&G DOLCE & GABBANA mark) and NOR Exhibit 51 (an article that mentions that during an interview Mr. Dolce “sported a baseball cap with the ‘D&G’ initials”). These articles, however, and the others like them, are only admissible for what they show on their face, but not for the truth of the matters stated therein. *Syngenta Crop Protection Inc. v. Bio-Check LLC*, 90 USPQ2d 1112, 1117 n.7 (TTAB 2009) (printed publications probative only for what they show on their face, not the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters). As such, the references to “D&G” in these articles are inadmissible to show that the D&G mark was in use in 1995, or that clothing bearing the D&G mark was for sale in the United States at that time.



**V. CONCLUSION**

For the foregoing reasons, Jay-Y respectfully requests that the Board strike the testimony of Mr. Lupano, and Exhibit 49, in their entirety and that such testimony and documentary evidence not be considered in determining the issues in this proceeding.

In addition, Jay-Y respectfully requests that the Board only consider Gado's printouts of articles for what they show on their face, and not for the truth of the matters stated therein.

SEYFARTH SHAW LLP

Dated: December 23, 2011

By: s/ Kenneth L. Wilton  
Kenneth L. Wilton  
Julia K. Sutherland  
Attorneys for Respondent and Counterclaimant  
JAY-Y ENTERPRISE CO., INC.

2029 Century Park East, Suite 3500  
Los Angeles, CA 90067-3021  
Telephone: (310) 277-7200  
Facsimile: (310) 201-5219

**CERTIFICATE OF SERVICE**

I hereby certify that on December 23, 2011, I served the foregoing JAY-Y ENTERPRISE CO., INC.'S EVIDENTIARY OBJECTIONS TO NEW EVIDENCE REFERENCED IN GADO S.R.L.'S BRIEF IN OPPOSITION TO THE COUNTERCLAIM AND IN REPLY TO RESPONDENT'S OPPOSITION BRIEF on Petitioner and Counterclaim Respondent Gado S.R.L. ("Gado") by depositing a true copy thereof in a sealed envelope, postage prepaid, in First Class U.S. mail addressed to Gado's counsel as follows:

Mark Lerner, Esq.  
Robert Carrillo, Esq.  
Satterlee, Stephens, Burke & Burke LLP  
230 Park Avenue, 11th Floor  
New York, NY 10169

/s/ Kenneth L. Wilton

Kenneth L. Wilton